

REMARKS

At the time of the Office Action dated August 1, 2006, claims 1-14 were pending and rejected in this application. Claims 1, 5, 7, 10, and 12 have been amended, and care has been exercised to avoid the introduction of new matter. Specifically, claims 5 and 10 have been amended by incorporating the limitations of claims 6 and 11, respectively, therein, and consequently claims 6 and 11 have been cancelled. Claims 7 and 12 have been amended to address dependency issues arising from the cancellation of claims 6 and 11. Claim 1 has been amended to include limitations substantially similar to the limitations added to claims 5 and 10. Applicants submit that the present Amendment does not generate any new matter issue.

**CLAIMS 1-14 ARE REJECTED UNDER 35 U.S.C. § 102 FOR ANTICIPATION BASED UPON
FELLENSTEIN, U.S. PATENT NO. 6,747,555**

On pages 2 and 3 of the Office Action, the Examiner asserted that Fellenstein discloses the invention corresponding to that claimed. This rejection is respectfully traversed.

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single reference.¹ As part of this analysis, the Examiner must (a) identify the elements of the claims, (b) determine the meaning of the elements in light of the specification and prosecution history, and (c) identify corresponding elements disclosed in the allegedly anticipating reference.² This burden has not been met. Moreover, the Examiner has failed to clearly designate the teachings in

¹ In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

² Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., *supra*.

Fellenstein being relied upon the statement of the rejection. In this regard, the Examiner's rejection under 35 U.S.C. § 102 also fails to comply with 37 C.F.R. § 1.104(c).³

With regard to claims 5-14, the Examiner asserted on page 3 of the Office Action that these claims "recite subject matter that is met as discussed in claims 1-4 above." Applicants respectfully disagree. Claims 5-14 include subject matter than was not claimed in claims 1-4. For example, both claims 6 and 11 recite subject matter (now incorporated into independent claims 5 and 14) that are directed to a subset of registered RFID tags. However, claims 1-4, as previously presented, are silent as to this limitation.

Upon reviewing Fellenstein, Applicants are unable to determine where Fellenstein identically discloses the limitation added to claims 5 and 10 within the meaning of 35 U.S.C. § 102. Applicants, therefore, respectfully submit that independent claims 5 and 10 are not anticipated by Fellenstein. Moreover, since claim 1 has been amended to recite limitations similar to those added to claims 5 and 10, Applicants submit that claim 1 is also not anticipated based upon Fellenstein. Therefore, for the reasons stated above, Applicants respectfully solicit withdrawal of the imposed rejection of claims 1-5, 7-10, and 12-14 under 35 U.S.C. § 102 for anticipation based upon Fellenstein.

³ 37 C.F.R. § 1.104(c) provides:

In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

Although Applicants believe that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

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Respectfully submitted,

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